

to practice prior to August 6, 1997 to remove the rejections in view of Matsushita et al. A full copy of the Declaration with Appendix A is included herewith.

With regard to the rejections of claims 1-24 and 31-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dams (U.S. Patent No. 4,355,129) in combination with Milbert (U.S. Patent No. 3,821,140), it was agreed at the interview that "Dams does not teach a silane coated ATH while Milbert does not teach ATH at all, therefore, neither Dams nor Milbert teaches the claimed composition." (Interview Summary) In this regard, Applicants' counsel pointed out that, at best, Dams showed silane coupling of aluminum oxide filler. However, the Examiner was referred to the text of Hawley's Condensed Chemical Dictionary (13<sup>th</sup> ed., revised by Richard J. Lewis, Sr., 1997) which shows that aluminum trihydrate is chemically distinct from aluminum oxide filler. The Examiner thus agreed that Dams does not disclose or suggest coating ATH with a silane coupling agent. As such, it was agreed that the rejections of claims 1-24 and 31-32 under 35 U.S.C. § 103(a) are traversed.

Accordingly, Applicants respectfully submit that the claims of the application are in condition for allowance and respectfully request that a Notice of Allowance be issued on an expedited basis.

In the event that the Examiner has any questions concerning this Request for Reconsideration, or the above-identified application in general, the Examiner is invited to contact the undersigned attorneys concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

Dated: Sept. 12, 2002

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Serial No. 09/000,824  
Attorney Docket No. 41980.002004

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of  
Jayantha AMARASEKERA et al.

Serial No. 09/000,824

Filed: December 30, 1997

For: SILICONE COMPOSITIONS FOR  
HIGH VOLTAGE INSULATOR  
APPLICATIONS

Art Unit: 1713

Examiner: C. Lu Rutt

RECEIVED

SEP 18 2002

TC 1700

Assistant Commissioner of Patents  
Washington, D.C. 20231

DECLARATION OF PRIOR INVENTION IN THE UNITED STATES TO OVERCOME  
CITED PATENT OR PUBLICATION 37 CFR 1.131

PURPOSE OF DECLARATION

This declaration is to establish conception and reduction to practice of the invention of this application in the United States, at a date prior to August 6, 1997, the date of publication of EP 0787 772.

DECLARANTS

The persons making this declaration are the inventors Jayantha Amarasekera and James Edward Doin.

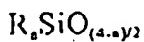
FACTS AND DOCUMENTARY EVIDENCE

To establish the date of conception and reduction to practice of the invention of this application, a notebook page, attached as Appendix A, is submitted as evidence. From the notebook page attached as Appendix A it can be seen that the invention of this application

was conceived and reduced to practice in the United States of America before the date of August 6, 1997, which is a date earlier than the publication date of the European Application.

Claim 17 of the application requires:

(A) 100 weight parts organopolysiloxane gum having at least 2 silicon-bonded alkenyl groups in each molecule and the average compositional formula:



in which R is selected from substituted and unsubstituted monovalent hydrocarbon groups and a has a value from 1.95 to 2.05,

(B) 15 to 300 weight parts aluminum hydroxide powder,  
(C) 0.1 to 1 weight part of a silane treating agent, and  
(D) 0.1 to 5 weight parts of a peroxide based curing agent, wherein said silane treating agent (C) is present in an amount effective to act as a surface modifier for the aluminum hydroxide powder.

Referring to the portion of notebook page labeled as "Notebook Ref. 492-4002" presented in Appendix A, SE6035 and SE6160 are organopolysiloxane compounds in amounts of 40 parts and 60 parts, respectively, for a total of 100 parts of organopolysiloxane compound. SE 6160 is a compounded methyl vinyl silicone rubber containing 64.4% by weight of a methyl vinyl silicone and SE 6035 is a compounded methyl vinyl silicone rubber containing 76.3% by weight of a methyl vinyl silicone. The other ingredients in these two rubber compounds are fillers and processing aids and in the case of the SE 6160 a small amount of a silazane cross linking agent. Hydral 710 is aluminum hydroxide powder in an amount of 100 parts. SC3735 is a silane treating agent in an amount of 0.5 parts. A

handwritten notation in the corner of this document indicates 1.8 parts of a peroxide catalyst which is a peroxide based curing agent.

Further the notation "insulator compound for Tosil" appears at least three times on the notebook page bearing the formulation. Testing of the composition is evidenced by a signature in the blank following "Compd. Tested By" and the listing of test data provided in the lower portion of the "Notebook Ref. 492-4002" document.

#### TIME OF PRESENTATION OF THE DECLARATION

This declaration is submitted with a response to an office action of August 11, 2000.

## DECLARATION

As a person signing below:

I hereby declare that all statements made here and of my own knowledge are true and that statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the likes so made are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

## SIGNATURES

Full Name of Inventor: Jayantha Amarasekera

Inventor Signature: Jayantha Amarasekera

Date: 5/17/01 Country of Citizenship: USA

Residence: 109, Gloucester Street, Clifton Park, NY 12065

P.O. Address: As above

Full Name of Inventor: James Edward Doin.

Inventor Signature: James Edward Doin

Date: 5/17/01 Country of Citizenship: USA

Residence: 3881 NY 7 Hoosick Falls, N.Y. 12090

P.O. Address: AS ABOVE

87

tive: Formulations for Insulation Compounds Reaction No. 451  
 TOSIL 492-4001 & 492-4002 Date \_\_\_\_\_

Continued  
From Page \_\_\_\_\_

### RUBBER-T.M.O.

PROJECT: Insulation Compound  
 ACCOUNT: for TOSIL  
 APPLICATION: \_\_\_\_\_

DATE ORIGINATED \_\_\_\_\_  
 REQUEST COMPL. DATE \_\_\_\_\_  
 AL. COMPL. DATE \_\_\_\_\_  
 COMPO. TESTED BY Larwood

MSR Mix   
 Doughmix   
 Banbury   
 Date \_\_\_\_\_

Notebook Ref. 492-4002

	A	B	C
SE 6035 6-189	40	40	
SE 6160 8571A	60	60	
Hybrid 710	100		
E & 3735	.5	.3	.5
G-4 331 (6670)			100
		100	
492-4001			
	76/198		171/198

Void Time 287

Age in Days	Part	Shore A	Tensile	Flex
0	1	81	75	75
1035	2	69	99.0	
156	3	77	118	
1035	4	70	94	
156	5	1.51	155	
1035	6	104.6	39.4	

TESTS:

Coldry 400

1.5 parts  
Vaseline  
10 min.  
(5 min.)

DATE ORIGINATED \_\_\_\_\_  
 REQUEST COMPL. DATE \_\_\_\_\_  
 AL. COMPL. DATE \_\_\_\_\_  
 COMPO. TESTED BY Larwood

MSR Mix   
 Doughmix   
 Banbury   
 Date \_\_\_\_\_

Notebook Ref. 492-4001

PROJECT: Insulation Compound  
 ACCOUNT: for TOSIL  
 APPLICATION: \_\_\_\_\_

SE 6740	50	200
Hybrid 710	50	200

Void Time 350

Time 10 min.

TESTS:

Coldry 400

1.5 parts  
K5670

Age in Days	Part	Shore A	Tensile	Flex
0	1	64		
47	2	47		
371	3			
74	4			
277	5			
413	6			

Net 400 parts sample

Continued On Page \_\_\_\_\_

Date \_\_\_\_\_

Date \_\_\_\_\_

Work By mead

Witnessed and Understood By R.W. Sander